

REMARKS

By this amendment, claims 1, 7, 12, 16, 22, 27, 31, and 36 are amended. New claims 41 and 42 are added. The amendments to the claims find support in the specification at least on page 38, lines 18-24. No new matter has been introduced. Claims 15 and 30 are cancelled. Claims 1-14, 16-29, and 31-42 are pending. Applicants would like to take this opportunity to thank Examiner Brown for granting a personal interview with applicants' representatives. Entry of the above amendments and a favorable first action on the merits is earnestly solicited.

Rejection under 35 U.S.C. § 103

Claims 1-6, 16-21, and 27-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,621,456 to Florin (hereafter Florin) in view of U.S. Patent 5,715,315 to Handelman (hereafter Handelman) for reasons stated on page 3-7 of the Final Office Action. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP § 2142.). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Florin is directed to a method and apparatus for providing an interactive audio-visual interface for the display of multiple program categories. Handelman is directed to a CATV system that transmits encrypted information individually addressed to a subscriber unit. As agreed to by the Examiner during the interview, Florin and Handelman, individually and in combination, do not disclose or suggest "interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications," as recited in independent claims 1, 16, 31, and 36. Moreover, Florin and Handelman, individually and in combination, do not disclose or suggest "communicating with on-line databases, interactive services and message services outside of the television program delivery system," as recited in independent claim 27.

Since none of the cited references disclose or suggest each and every element of the claims, a combination of the cited references also does not teach or suggest each and every element of the claims. Accordingly, Applicants respectfully submit that claims 1, 16, 27, 31 and 36 are not rendered obvious by Florin and Handelman. Withdrawal of the 35 U.S.C. 103(a) rejection to independent claims 1, 16, 27, 31, and 36 is respectfully requested.

If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and MPEP § 2143.03. Applicants respectfully submit that claims 2-6, 17-21, 28, 29, 32-35, and 37-40 are allowable because they depend from allowable claims 1, 16, 27, 31, and 36, respectively, and for the additional features they recite. Applicants therefore respectfully request withdrawal of the rejection of claims 2-6, 17-21, 28, 29, 32-35, and 37-40 under 35 U.S.C. § 103 (a).

Claims 7-10, 12-14, and 22-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,003,591 to Kauffman (hereafter Kauffman) in view of U.S. Patent No. 5,223,924 to Strubbe (hereafter Strubbe) for reasons stated on pages 7-11 of the Office Action. Applicants respectfully traverse the rejection.

Kauffman describes a cable television converter with remotely modifiable functionality to receive firmware downloaded over a cable television network.

Kauffman, however, does not teach or suggest “interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications,” as recited in independent claims 7 and 22.

Strubbe describes a user interface that can access downloaded TV program information, automatically correlate this information with the preferences of the user, create and display at least one program information database based upon the results of the correlation. In essence, Strubbe describes a one-way programming with a customized display at the user’s site, but not “interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications.” Therefore, Strubbe does not cure the deficiency in Kauffman. Accordingly, Applicants respectfully submit that Kauffman and Strubbe, individually and in combination, do not render claims 7 and 22 obvious to one skilled in the art.

With respect to independent claim 12, Applicants respectfully submit that Kauffman and Strubbe, individually and in combination, do not disclose or suggest “a hardware upgrade comprising a telephone modem, connected to the menu generator adapted to provide communications capability with on-line databases, interactive services and message services.” Kauffman describes that the converter 40 may display information on a user’s television set and that an e-mail feature can also be provided, thus “enabling a subscriber to send and receive text message on his television via the cable system.” However, sending and receiving text message on his television via the cable system does not provide communications capability with on-line

databases. Strubbe mentions nothing about e-mail or menus, let alone a menu generator adapted to provide communications capability with on-line databases, interactive services and message services.. Accordingly, Applicants respectfully submit that claim 12 is not rendered obvious by Kauffman and Strubbe. Withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

Applicants further submit that claims 8-10, 13-14, and 23-25 are allowable because they depend from allowable claims 7, 12, and 22, respectively, and for the additional features they recite. Withdrawal of the rejection under 35 U.S.C. §103 (a) is respectfully requested.

Claims 11, 15 and 26 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Kauffman and Strubbe, in view of U.S. Patent No. 5,561,709 to Remillard (hereinafter Remillard) for reasons stated on page 11 of the Office Action.

Claim 15 has been cancelled and the rejection is now moot. With regard to claims 11 and 26, Applicants respectfully traverse the rejection. Claims 11 and 26 depend from independent claims 7 and 22, respectively, and further comprise a telephone modem (claims 11) or the step of communicating with other services outside of the television program delivery system (claim 22). As discussed earlier, independent claims 7 and 22 are patentable over Kauffman and Strubbe because Kauffman and Strubbe, individually and in combination, do not teach or suggest "interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications." Remillard does not cure this defect. Remillard teaches using a modem to access a variety of services such as other electronic devices, networks, personal computers, databases and facsimile or telex services. Remillard, however, does not teach or suggest anything about online applications. Accordingly, Applicants respectfully submit that Remillard does not render claims 7 and 22 obvious in view of Kauffman and Strubbe. Applicants further submit that claims 11 and 26 are allowable because they depend from allowable claims 7 and 22, respectively, and for the additional features they recite. Withdrawal of the rejection under 35 U.S.C. §103 (a) is respectfully requested.

Finally, new claims 41 is directed to a hardware upgrade card for enhancing the functionality of a set top converter. As agreed to by the Examiner during the interview, neither Florin nor Handelman teaches or suggest a hardware upgrade card for enhancing the functionality of a set top converter. Accordingly, Applicants respectfully submit that new claim 41 is patentable over Florin and Handelman. Applicants further submit that new claim 42 is

patentable over Florin and Handelman because it depend from new claim 41 and because it recited additional patentable subject matter, *i.e.*, the interactive programming instructions that enable the subscriber to engage in textual interactivity with online applications.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: **December 30, 2003**


Michael Ye
Registration No. 47,195
ANDREWS KURTH LLP
1701 Pennsylvania Ave, N.W.
Suite 300 South
Washington, DC 20006
Tel. (202) 662-2700
Fax (202) 662-2759